

**REMARKS**

Claims 1 and 3-16 are pending in this application. By the Office Action, claims 4 and 15 are allowed; claims 5-12 are withdrawn from consideration; and claims 1-3, 13, 14, and 16 are rejected under 35 U.S.C. §102. By this Amendment, claim 2 is canceled and claims 1, 3, 13, 14, and 16 are amended. Support for the amendments to claims 1 and 14 can be found in claim 2 as originally filed. No new matter is added.

I. Examiner Interview

Applicant thanks the Examiner for the courtesies extended his representative in the March 15, 2005, telephone interview. During the telephone interview, the outstanding rejection and the pending claims were discussed. Applicant's further separate record of the substance of the interview is incorporated into the following remarks.

II. Misdirected Forms PTO-1449

The November 24, 2004, Office Action included two initialed Forms PTO-1449 (copy attached). However, the initialed Forms PTO-1449 enclosed with the Office Action do not relate to the above-identified U.S. Patent Application No. 09/998,340. Instead, the Forms PTO-1449 clearly indicate that they relate to U.S. Patent Application No. 10/215,933, having a different Applicant, filing date, and attorney docket number. The incorrect Forms PTO-1449 also appear as entries in the Image File Wrapper system for the present application, U.S. Patent Application No. 09/998,340.

Because the Forms PTO-1449 do not belong with this application, Applicants request that the incorrect Forms PTO-1449 be removed from the application file of the present application.

III. Allowable Subject Matter

Applicant thanks the Examiner for the indication that claims 4 and 15 are allowed.

IV. Rejections Under 35 U.S.C. §102(e)

Claims 1-3, 13, 14, and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by Sarkar et al. (U.S. Patent No. 6,465,081) ("Sarkar"). By this Amendment, claims 1 and 14 are amended to incorporate the subject matter of claim 2. Applicant respectfully traverses the rejection with respect to the amended claims.

As amended, independent claim 1 is directed to an image recording material comprising: a substrate having transparency; an image being formable by an electrophotography system on one side of the substrate; and a transparent characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling member comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a charge controlling agent and wherein the image can be seen when viewed through the substrate. Independent claim 14 is directed to an image recording material comprising: a substrate having transparency; an image being formable by an electrophotography system on one side of the substrate; and a characteristic controlling means provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling means comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a charge controlling agent and wherein the image can be seen when viewed through the substrate. Such image recording materials are nowhere disclosed in Sarkar.

Sarkar is cited as disclosing an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (Office Action, page 2). According to the Office Action, the ink repellent layer of Sarkar is

transparent and corresponds to the side of the substrate wherein the electrophotographic image is formed in the claims, and the ink receptive layer of Sarkar is transparent, comprises resin and filler, and corresponds to the characteristic controlling member in the claims. The Office Action further asserted that the Sarkar substrate is transparent.

The Examiner concluded that, "[s]ince the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer *inherently* functions as [a] glossiness controlling layer that reduces glossiness. Since all three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate" (emphasis added) (Office Action, page 2). However, Sarkar does not disclose all of the limitations of the claimed invention.

According to Sarkar, the ink receptive layer is coated on the side of the substrate that receives the image (col. 9, Example 9). The ink receptive coating comprises at least one layer of a hydrophilic polymer or blend of polymers and may include additives, such as fillers (col. 5, line 60, to col. 6, line 15). The filler "may be used to modify the mechanical properties of the [ink-receptive] coating" and may include colloidal silica and alumina (col. 6, lines 39-42).

The Office Action argues that the Sarkar ink receptive layer corresponds to the characteristic controlling member of the claims. However, in claims 1, 3, 13, 14, and 16 the characteristic controlling member controls, including reduces, glossiness. For all of the reasons presented in Applicant's previous Amendment, there is no indication in Sarkar that the ink receptive layer has or even could be made to have this capability. In order to anticipate a claim, the cited reference must disclose every limitation of the claim. Since Sarkar does not disclose glossiness control, Sarkar cannot anticipate the claims.

Furthermore, Sarkar fails to disclose the limitation of amended claims 1 and 14 that the characteristic controlling member comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a charge controlling agent.

According to the claimed invention, by adding a charge controlling agent to the glossiness controlling layer, the surface resistance value of the image recording material that is required for electrophotography systems can be obtained. For example, the specification describes that the charge controlling agent is used for achieving a suitable surface resistance, and that examples of the charge controlling agent include surfactants and conductive inorganic oxides. Page 42, line 20 to page 43, line 21. As a result, transferring property can be improved in the image transferring process. However, Sarkar does not disclose incorporating such a charge control agent into the glossiness controlling layer, and does not disclose that any benefits could be obtained thereby.

During the March 15, 2005, telephone interview, the Examiner questioned the meaning of "charge controlling agent." In response, Applicants respectfully submit that charge controlling agents are described in the specification, and are well known to one of ordinary skill in the art. For example, the charge controlling agents are described in the specification at page 42, line 20 to page 43, line 21, and specific examples of charge controlling agents are disclosed therein, as well as in the Examples. Attached hereto is a partial translation of an article, Kyousuke Takahashi and Kouji Kitamura, Ed., "Digital Hard Copy Gijitsu to Zairyou," (Technologies and Materials for Digital Hardcopy) published by CMC Publishing Co., Ltd., pages 198-207, December 21, 1999. This article discloses, at page 205, that a cationic surfactant or a polymer having a quaternary ammonium salt as a branch thereof is often used as a material for imparting electrical conductivity to the film. The article also discloses that fine oxide particles have also been proposed.

Furthermore, "charge control agent" and "charge controlling agent" are terms and materials that are well known in the art. For example, a recent keyword search on the USPTO internet website patents database, revealed 2,427 patents since 1975 citing the term "charge control agent" with at least 567 of those patents using the term in the claims, and

1,130 patents since 1975 citing the term "charge controlling agent" with at least 165 of those patents using the term in the claims. This search further demonstrates that such charge controlling agents are well known in the art.

Because Sarkar does not disclose the use of charge controlling agents, as claimed, Sarkar cannot anticipate the pending claims.


Accordingly, claims 1, 3, 13, 14, and 16 are patentable over Sarkar. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

Joel S. Armstrong  
Registration No. 36,430

JAO:JSA

Attachments:

Two Forms PTO-1449

Partial Translation of Kyouskue Takahashi and Kouji Kitamura, Ed., "Digital Hard Copy Gijitsu to Zairyou," (Technologies and Materials for Digital Hardcopy) published by CMC Publishing Co., Ltd., pages 198-207, December 21, 1999

Date: May 24, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

Please type a plus sign (+) inside this box →

+

PTO/SB/08A (08-00)

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Substitute for Form 1449A/PTO OCT 06 2004 INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Application Number	10/215,933		
		Filing Date	August 9, 2002		
		First Named Inventor	Kenzo KASAHARA		
		Group Art Unit	1774		
		Examiner Name	Betelhem Shewareg		
Sheet	1	of	2	Attorney Docket Number	02440/HG

## U.S. PATENT DOCUMENTS

Exam. Inits. <sup>1</sup>	Cite No. <sup>1</sup>	Document Number	Kind Code <sup>2</sup>	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion
BS.		4,832,984		Hasegawa et al.	05-23-1989	
<del></del>						

## FOREIGN PATENT DOCUMENTS

Exam. Inits. <sup>1</sup>	Cite No. <sup>1</sup>	Offc. <sup>3</sup>	Document Number <sup>4</sup>	Kind Code <sup>5</sup>	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion	T <sup>6</sup>
BS	—	EP	0 992 359	A2	Nippon Paper Ind Co	04-12-2000		
<del></del>								

Examiner Signature	<i>BH</i>	Date Considered	11/2004
--------------------	-----------	-----------------	---------

<sup>1</sup> EXAMINER: Initial if document considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>2</sup> Unique citation designation number. <sup>3</sup> See kinds of U.S. Patent Documents. <sup>4</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>5</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>6</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>7</sup> Place a check here if English translation is attached.

DATE MAILED: October 6, 2004

THIS PAGE BLANK (US 9)

Please type a plus sign (+) inside this box →

+

PTO/SB/08B (08-00)

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

OCT 06 2004

Substitution for Form 1449A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

Application Number	10/215,933
Filing Date	August 9, 2002
First Named Inventor	Kenzo KASAHARA
Group Art Unit	1774
Examiner Name	Betelhem Shewareged
Attorney Docket Number	02440/HG

Sheet 2 of 2

**OTHER DOCUMENTS - NON-PATENT LITERATURE DOCUMENTS**

Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Include name of author (in CAPITAL LETTERS), title of article, title of item, date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
BS		PATENT ABSTRACTS OF JAPAN, vol. 0122, No. 82 (M-726), 3 August 1988 of JP 63 060784 A (Fuji Photo Film Co. Ltd.), 16 March 1988	

Examiner Signature	<i>B/S</i>	Date Considered	11/2004
-----------------------	------------	--------------------	---------

\* EXAMINER: Initial if document considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.  
\* Unique citation designation number. \* Place a check here if English translation is attached.

DATE MAILED: October 6, 2004